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REMARKS

Claims 1 to 9, 13, 14, 21 to 31, 35, 36, and 43 to 50 are pending in the present application. Claims 10, 11, 32 and 33 are withdrawn. Claims 1 and 23 have been amended and support for the amendment may be found in the Examples, pages 23 to 31. New claims 57-60 have been added, leaving claims 1 to 9, 13, 14, 21 to 31, 35, 36, 43 to 50, and 57-60 for consideration upon entry of this amendment. Reconsideration and allowance of the claims is respectfully requested in view of the following remarks.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-9, 12, 14, 21-31, 35, 36, and 43-50 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 5,852,085 to Brown et al. (hereinafter referred to as "Brown") in view of U.S. Patent No. 5,391,594 to Romenesko et al. (hereinafter referred to as "Romenesko"). The Examiner has asserted that one of ordinary skill in the art would have been motivated by the teachings of Romenesko to add the silicone rubber powder taught therein to the thermoplastic composition of Brown in an effort to obtain the known benefits and improvements. Applicants respectfully traverse this rejection.

Brown discloses "thermoplastic compositions" which meet the long felt need for transparent articles. (Col. 2, lines 11-12) The transparent composition comprises a polyetherimide resin, at least one resin selected from the group consisting of polycarbonate resins, poly(ester-carbonate) resins, and polyarylate resins, and an effective amount of a catalyst to provide transparency to the composition. The required inclusion of the catalyst emphasizes the desire for transparency. Brown does not teach or suggest the inclusion of a polysiloxane.

Romenesko discloses a free-flowing silicone polymer powder prepared by mixing a polydiorganosiloxane with a silica filler. The silicone polymer powder may be dispersed in an organic resin and improve the burn character of the resin. (Abstract) Exemplary organic resins include thermosetting polyimides and thermoplastic polycarbonates. (Col. 4, line 53 to Col. 5, line 2)

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For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

The amended claims, as well as the new claims, preclude the presence of the catalyst required by Brown. Support for the amendments to the independent claims can be found in the Examples which do not employ a catalyst as taught by Brown. It is here noted that MPEP 2173.05(i) provides an explanation as to the use of negative limitations. This section provides:

Any negative limitation or exclusionary proviso must have basis in the original disclosure. *** **Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support.** *Ex parte Parks*, 20 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1193). (Emphasis supplied.)

In *Ex parte Parks*, the Examiner had rejected the limitation "in the absence of a catalyst" because there was no literal statement in the specification to support the limitation. The Board held that "literal support does not, in and of itself, establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112." *Id.* The Board also held that **"it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed."** *Id.* (Emphasis supplied.) In footnote 3, the Board points out that "whether the requirement for an adequate written description has been met is a question of fact and, hence, driven by the exigencies of each case."

Moreover, the Board of Patent Appeals & Interferences has consistently held that the specification does not require a literal statement supporting a negative limitation. In *Ex parte Kenneth E. Starling Jr., and Brian J. Love*, 1995 WL 1696871, *2 (Bd. Pat. App. & Inter. 1995), the claim language at issue was "curable without the application of any supplemental heat." The Board held, "Although the disclosure is silent as to the use of heat, **it can reasonably be said that appellants' silence would have disclosed to one of ordinary skill in the art that the dental adhesive would have been "curable in the absence of heat."** *Id.* (Emphasis supplied.) Similarly, while the instant specification is silent as to the use of a

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catalyst, it could be reasonably be said that it's absence would be an indication to one of ordinary skill in the art that the composition was free of such a catalyst, particularly when the Examples do not include one. Thus, while Applicants' specification does not literally state Applicants' negative limitation as recited in Claim 1, 35 USC 112, first paragraph, does not require a literal statement in the specification.

With respect to the use of the transitional phrase "consisting essentially of", for example as in the amended claim 23, Applicants respectfully note that based on the teaching of Brown it is clear that the catalyst affects the interaction of the polymers so as to make the composition transparent. It is reasonable to believe that the catalyst's interaction with the polymers may also have an effect on other physical properties such as impact strength, particularly when there are three polymers involved as is instantly claimed.

Finally Applicants respectfully note that new claim 59 uses the transitional phrase "consisting of" which precludes the inclusion of the catalyst as taught by Brown.


In conclusion, Applicants assert that a prima facie case of obviousness has not been, and cannot be, made because the composition as taught by Brown does not teach the claimed composition, namely a composition free of a catalyst, and Romenesko has been cited for its teaching with regard to the silicone rubber powder and does not teach all the elements of the pending claims. Applicants respectfully assert that the rejection should be withdrawn.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862.

Respectfully submitted,

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